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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/827,446	04/20/2004	Kazumi Minoguchi	0051-0226PUS1	2718
2292 7590 03/20/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
SEVERSON, RYAN J				
ART UNIT		PAPER NUMBER		
3731				
NOTIFICATION DATE		DELIVERY MODE		
03/20/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/827,446	Applicant(s) MINOGUCHI ET AL.
Examiner Ryan J. Severson	Art Unit 3731

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 6-10.
Claim(s) withdrawn from consideration: 1-5 and 11-17.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Anhtuan T. Nguyen/
Supervisory Patent Examiner, Art Unit 3731

/R. J. S./
Examiner, Art Unit 3731

Continuation of 3. NOTE:

The amendments to independent claim 6 to clarify which portions of the tooth-hardening member have harder and softer portions changes the scope of the claims, thereby requiring further consideration and search. Further, applicant has introduced new claim 18 without cancelling a corresponding number of finally rejected claims. .

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues dependent claim 17 was improperly withdrawn from consideration. However, as applicant is presumably aware, a dependent claim requires ALL of the limitations of the claim(s) from which it depends. In the instant case, claim 17 is written to depend from claim 1, and thereby includes ALL of the limitations of claim 1. Independent claim 1 requires a "nipple" structure (and therefore is not a generic claim), which is only shown in non-elected embodiment 1 (see the Restriction Requirement mailed 8/15/2007 and the Response filed 10/15/2007). In that response, applicant explicitly elected embodiment 2, and stated that only claims 6-10 read on the elected embodiment. As such, claim 1 was withdrawn from further consideration as being drawn to a non-elected species. Since claim 1 is withdrawn, all claims that depend directly or indirectly therefrom also must be withdrawn, regardless of the limitations expressed therein, because each of those dependent claims include the limitations of a non-elected species (from claim 1). Therefore, applicants argument in this regard is not persuasive, and claim 17 remains withdrawn from further consideration.

Applicant argues that the citation of the published patent application to Dunn et al. was improper because it was not used in the rejection. However, Examiner can find no factual basis to support applicant's argument in this regard. Dunn et al. was merely cited to show the state of the prior art as being pertinent prior art to the claimed invention, and in no way is it required to be used in a rejection. In fact, the practice of citing pertinent prior art by an Examiner without applying that prior art in a rejection is common in the USPTO. Therefore, the previous final rejection will not be withdrawn to include a rejection based on Dunn et al. Further, the Dunn et al. published applicant will remain of record in this application.

Applicant further argues the combination of Nakata and Suchowski is improper because the device of Nakata is for children and the device of Suchowski is for dogs. However, this does not prevent a proper combination from being made. The context of obviousness-type rejections is not so-limited as to require identical devices. As applicant is presumably aware, analogous prior art can be shown by being EITHER in the same field of applicant's endeavor, OR being reasonably pertinent to the problem with which applicant was concerned. In the instant case, Nakata is in the same field of endeavor, and Suchowski is reasonably pertinent to the problem with which applicant was concerned. To clarify, Suchowski is drawn to a chewing device having sections with different hardnesses, which is at a minimum reasonably pertinent to the problem with which applicant was concerned. Therefore, a prior art device need not be drawn to a chewing device for children to be properly applied in a rejection of the outstanding claims. Further still, at no point was the structure of Suchowski relied upon, and therefore arguments drawn to the differing structures of the prior art are essentially moot.

Further, Dunn et al. is in the applicants field of endeavor AND is pertinent to the problem with which applicant was concerned. Again, Dunn et al. is merely being cited here to show the state of the art (to further provide evidence that applicant has not devised a novel and non-obvious invention) and is not being relied upon to reject the claims.

Applicant further argues none of the cited art disclose a "tooth-hardening device." However, this merely gives a name and intended use to the claimed invention, and in no way limits the structure of the claims. As applicant is presumably aware, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In the instant case, there is no inherent structure associated with a "tooth-hardening device," and therefore this term can not add any structural limitation to the claims.